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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,368	04/01/2004	Ian Eisenberg		2885

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EXAMINER
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LEVINE, ADAM L

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/815,368

Applicant(s)

EISENBERG, IAN

Examiner

Adam Levine

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 4, 8, 12 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)                     | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application for the reasons indicated in the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be

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removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

### ***Specification***

The disclosure is objected to because of the following informalities: The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

A copyright notice appears at the bottom of the first page of the specification. This notice will not be permitted. A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(s). The content of the notice must be limited to only those elements provided for by law. For example, "©1983 John Doe" (17 U.S.C. 401) and "\*M\* John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the following authorization language is included at the beginning (preferably as the first paragraph) of the specification. 37 CFR 1.71(d).

The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by any-one of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever. 37 CFR 1.71(e).

The inclusion of a copyright or mask work notice in a design or utility patent application, and thereby any patent issuing therefrom, under the conditions set forth above will serve to protect the rights of the author/inventor, as well as the public, and will serve to promote the mission and goals of the U.S. Patent and Trademark Office. Therefore, the inclusion of a copyright or mask work notice which complies with these conditions will be permitted. However, any departure from these conditions may result in a refusal to permit the desired inclusion. If the authorization required under condition (C)

above does not include the specific language "(t)he (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent files or records,..." the notice will be objected to as improper by the examiner of the application. If the examiner maintains the objection upon reconsideration, a petition may be filed in accordance with 37 CFR 1.181. See MPEP §608.01(v) II. Examiner notes here that it appears applicant is claiming the entire application as subject to the copyright of the applicant. This is not permissible as it is inconsistent with the above. Appropriate correction is required.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

Claims 4 and 8-16 are objected to because of the following informalities:

1. Claims 4,8,12 and 16 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits. Appropriate correction is required.
2. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim that depends from a dependent claim should not be separated by any claim that does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n). Claim 10 depends from dependent claim 2 but is separated from it by claims 5-9. Claim 11 depends from dependent claim 3 but is separated from it by claims 5-10. Claim 14 depends from dependent claim 6 but is separated from it by claims 9-13, and claim 15 depends from dependent claim 7 but is separated from it by claims 9-14.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-8 and 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 5-8 and 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that they fail to point out what is included or excluded by the claim language. These claims are omnibus type claims. Claims 13-16 provide for the use of a method comprising the use of a system, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Further, claims 5-8 describe a system comprising a method. Taking

independent claim 5 together with dependent claims 6-16, it is impossible to determine what applicant regards as the invention.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 5-8 and 13-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). At the same time defining a system as comprising a method and then claiming a method of using the system ultimately does not adequately claim either. The invention appears to be trying to claim inventions that straddle two different classes of invention without clearly and distinctly claiming any single invention within either class.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –



(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**5. Claims 1,5,9, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Husemann (US Pub.No.2001/0037264).**

Husemann teaches all the limitations of claims 1,5,9, and 13. For example, Husemann teaches a method enabling a customer to order a deliverable product or service using a mobile phone that utilizes SMS text messages in the transaction process. Husemann further discloses:

- a purchaser calling a service provider/vendor from a mobile phone device: (see at least abstract, figs.5-6; page 1 para.0008, pages 4-5 paras.0057, 0065, 0071-0074; page 6 para.0085)
- an SMS message forwarded to the purchaser's mobile phone: (by the vendor) relating to purchase of services and/goods options and/or terms of procuring services and/or goods (see at least page 5 para.0071-0074, page 6 para.0078, 0083-0085; page 7 para.0088)
- upon acceptance of the contents of the SMS message: purchaser is billed or charged a fee which allows access to vendor provided services and/or goods for a first determined time period (see at least abstract, page 2 para.0016, pages 4-5 paras.0065-0069, page 7 para.0088. Please note: the time period for performance of a transaction or for the providing of a service is a legal requirement inherent in any agreement or transaction.).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 2-3,6-7,10-11, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Husemann in view of Official Notice (regarding duplication of parts).**

Husemann teaches all of the above as noted under the 102(b) rejection and teaches a) ordering a selection of goods or services, b) ordering a group or a number of goods and/or services, and c) time periods governing transactions. Husemann discloses the claimed invention except for forwarding a second SMS message relating to the caller's agreement or approval of the contents of the second SMS message to be billed or charged a fee for a second determined time period for access to vendor provided services and/or goods and a plurality of SMS messages which are forwarded to the caller relating to the caller's agreement or approval thereof to be billed or charged a fee for a plurality of determined time periods for access to vendor provided services and/or goods. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include forwarding a second SMS message relating to the caller's agreement or approval of the contents of the second SMS message to be billed or charged a fee for a second determined time period for access to vendor provided services and/or goods and a plurality of SMS messages which are forwarded

to the caller relating to the caller's agreement or approval thereof to be billed or charged a fee for a plurality of determined time periods for access to vendor provided services and/or goods, since it has been held that mere duplication of essential parts involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references all teach systems and/or methods utilizing mobile telephones and SMS messages to perform transactions between buyers and sellers:

- Moreno, Eli; US Pub. No. 2002/0035515 (Nov. 2002).
- Barton et al.; US Pub. No. 2002/0072982 (June 2002).
- Kumar et al.; US Pub. No. 2002/0143634 (Oct. 2002).
- Simons et al.; US Pub. No. 2003/0014749 (Jan. 2003).
- Alie, Claude; US Pub. No. 2003/0055738 (March 2003).
- Silverstein et al.; US Pub. No. 2004/0093281 (May 2004).
- Kwei, Daniel Wah Hao; US Pub. No. 2004/0148228 (July 2004).
- Luo et al.; US Pub. No. 2004/0215526 (Oct. 2004).
- Wiesmuller et al.; US Pub. No. 2005/0027608 (Feb. 2005).
- Kulakowski, Henryk; US Pub. No. 2006/0156345 (July 2006).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine  
Patent Examiner  
November 19, 2006



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